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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,791	08/21/2003	Christopher Marrs	NEU-5008	8032

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EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/645,791	MARRS, CHRISTOPHER	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,11-15,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,11-15,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/24/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment filed 12/23/05 and IDS filed 1/24/06. Claims pending are 1-3, 7, 11-15, 22 and 23. Claims 1, 7, 11, 12 and 15 have been amended. Claims 4-6, 8-10 and 16-21 have been cancelled. Claims 23 and 23 have been added.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3, 11, 12, 14, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Yanagida et al. (US 5,484,816) or Stahl et al. (US 6,468,552) in view of Kim et al. (KR 2001070531 A), all of record.

a. Yanagida et al. in view of KR 2001070531 A.

Yanagida et al. teach external skin preparations comprising vitamin A (retinol), tocopherol, ascorbic acid and/or isoascorbic acid or a salt thereof. See col. 27-28, Examples 7-5, 7-7, 7-8 and 7-9. Yanagida et al. do not teach *Phellinus Linteus* extract of the instant claims. However, Kim et al. teach using *Phellinus Linteus* extract as an anti-oxidant for skin aging prevention and other beneficial skin effects. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic compositions of Yanagida et al. such that to employ *Phellinus Linteus* extract. One having ordinary skill in the art would have been motivated to do this to obtain an additional anti-oxidant/anti-skin aging effect as

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suggested by Kim et al. The determination of optimal or workable concentration of *Phellinus Linteus* extract by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired anti-oxidant/anti-aging properties of the composition.

b. Stahl et al. in view of KR 2001070531 A.

Stahl et al. teach cosmetic compositions for treating skin disorders such as hyperpigmentation, age spots, wrinkles, fine lines and other visible signs of skin aging, comprising (a) an oxygen labile active agent such as retinol, in an amount of 0.001-20%; (b) 0.05-0.5% of erythroic acid (isoascorbic acid) or a salt or ester thereof, (c) 0.001-1% of a tocopherol derivative, and other cosmetic agents. See Abstract; col. 1, lines 66-67; col. 2, lines 1-46; col. 4, lines 51-54; Examples. Stahl et al. do not teach *Phellinus Linteus* extract of the instant claims. However, Kim et al. teach using *Phellinus Linteus* extract as an anti-oxidant for skin aging prevention and other beneficial skin effects, such as improving skin color, freckles and liver spots by prevention of skin pigmentation or color deposition. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic compositions of Stahl et al. such that to employ *Phellinus Linteus* extract. One having ordinary skill in the art would have been motivated to do this to obtain skin-whitening and anti-skin aging effects as suggested by Kim et al. The determination of optimal or workable concentration of *Phellinus Linteus* extract by

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routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired skin-whitening and anti-skin aging properties of the composition.

2. Claims 1, 2, 7, 12, 13, 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Yanagida et al. (US 5,484,816) or Stahl et al. (US 6,468,552) in view of either Yarosh (US 6,103,746) or Catroux et al. (WO 01/87260 as translated by US 2004/0047823).

Yanagida et al. or Stahl et al. applied as above. Neither reference teaches ergothioneine of the instant claims. However, Yarosh teaches using L-ergothioneine in topical compositions for protecting mitochondria from oxidative damage due to exposure to sunlight and environmental toxins as discussed above. Similarly, Catroux et al. teach using ergothioneine as anti-pollution agent that protects the skin and keratin materials from deleterious effects of oxidizing agents, including UV radiation and ozone. See [0001]-[0019]; Examples. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic compositions of either Yanagida et al. or Stahl et al. such that to employ ergothioneine. One having ordinary skill in the art would have been motivated to do this to obtain anti-oxidant skin-protective effect as suggested by either Yarosh or Catroux et al.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

3. Applicant's arguments with respect to the rejection under 35 U.S.C. 112, second paragraph of Claims 12, 15 and those dependent thereon have been fully considered and are persuasive. The rejection has been withdrawn.
4. Applicant's arguments with respect to the rejection of Claims 1, 2, 4 and 5 under 35 U.S.C. 102(b) have been considered but are moot in view of the amendment to Claim 1 and cancellation of Claims 4 and 5.
5. Applicant's arguments with respect to the rejections under 35 U.S.C. 103(a) to the extent they are applicable to the amended claims have been fully considered but they are not persuasive.
6. In response to applicant's argument that the cited prior art does not recognize either *Phellinus linteus* extract or ergothioneine as retinol stabilizers, but teaches using these fungal extracts for different purposes (see pp. 6-7 of the reply), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
7. With respect to the showing of unexpected results in the specification, it is noted that such showing is not commensurate in scope with the instant claims. For Example, Claim 1 does not recite concentrations of either ingredient, but Example XIV in the specification exemplifies 1.78% of *Phellinus linteus* extract, Example XIII exemplifies

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33.33% of ergothioneine and all examples contain 0.21% of retinol. Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). Also see MPEP 716.02(d). The nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof. *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979). See MPEP above. Furthermore, almost all examples in the specification contain multiple antioxidants, e.g. tocopherol, isoascorbic acid, BHT, tocopheryl acetate, ascorbyl glucoside, etc. It is unclear whether or not the alleged unexpected stability of retinol is due to the combination of antioxidants or any particular antioxidant as suggested by the Applicant.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm
3/20/06


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